



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RE: Patent Application for : Dated: July 3, 1995
Kea Bardeen : Group: 1112
Serial No.: 08/182,409 : Examiner: B. Talbot
Filed: January 14, 1994 : Action: APPEAL BRIEF
For: METHOD AND KIT FOR :
DECORATING SURFACES WITH :
TRANSFER PATTERNS :

To: Board of Patent Appeals and Interferences
The Commissioner of Patents and Trademarks
Washington, D.C. 20231

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Sir:

This Appeal is from the Final Rejection of claims 1, 3, 4, 6-13, 15, 17, 20, 21 and 32 in the above-referenced application. In compliance with 37 C.F.R. §1.192, Appellant submits the following as her Appeal Brief in this matter through the undersigned counsel.

I. STATEMENT OF STATUS OF CLAIMS IN THE APPLICATION

This Application currently includes a total of 16 claims, a copy of which is attached hereto as Appendix A. In the Office Action, Paper No. 8, the Examiner finally rejected claims 1, 3, 4, 6-13, 15, 17, 20, 21 and 32. Claims 2, 5, 14, 18 and 19 had been previously canceled, and claims 16 and 22-31 were previously withdrawn from consideration under a restriction requirement.

Specifically, the Examiner rejected claims 1, 3, 4, 6-8, 11-13, 17, 20, 21 and 32 under 35 U.S.C. §103 over U.S. Patent No. 4,169,169 to Kitabatake and U.S. Patent No. 4,490,410 to Takiyama et al. Claims 9, 10, 15 and 21 were rejected under 35 U.S.C. §103 over Kitabatake and Takiyama et al in view of U.S. Patent No. 4,024,287 to Golchert. An analysis of the Examiner's rejection is provided below in Section VI.

II. STATEMENT OF STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

The Examiner's Final Rejection, dated January 3, 1995, Paper No. 8, was in response to Applicant's Amendment of September 30 1994. Applicant filed her Notice of Appeal on March 3, 1995. No Amendments were proposed by the Applicant subsequent to the Final Rejection of January 3, 1995.

III. CONCISE EXPLANATION OF THIS INVENTION

The present invention relates to a method of decorating a surface in order to display a design. It is particularly useful in decorating the outer surface of pumpkins, especially for Halloween.

Broadly, the claimed method includes a first step of covering the area to be decorated with a surface preparatory composition that has an initial first state that allows it to be spread on the surface of the item as a preparatory layer. Next, a pattern sheet is contacted with the preparatory layer, while the preparatory layer is still in the first state. The pattern sheet has a pattern formed thereon in a medium that will transfer onto the surface preparatory composition when it is in the initial state. The pattern sheet is contacted with the preparatory layer for a sufficient time to allow the medium forming the pattern to transfer onto the preparatory layer as a transferred pattern.

The surface preparatory composition is one which cures or is curable alone or by the application of a curing material, and the method includes the step of curing the preparatory layer into a final state thereby fixing the transferred pattern on the stable layer. The transferred pattern can either be the completed

decorative design, or the stable layer may be further colored or painted to bring out the decorative design features of the pattern, much in the manner of a coloring book. The broad method includes the step of removing the pattern sheet in contact with the preparatory layer after the transferred pattern has been transferred thereon but before the preparatory layer has cured such that the pattern sheet does not become adhered to the surface.

The surface preparatory composition is selected to be one that includes a solvent carrier base, and it is preferred that this solvent carrier be water-based. In either case, the medium is selected to be soluble in the base material. Where the solvent carrier is water-based, the medium used to form the pattern should be water-soluble. In that case, the pattern sheet may be (1) pre-printed with a pattern formed by the selected medium; (2) pre-printed with a pattern which is then traced with the selected medium so that the pattern may be transferred onto the preparatory layer; (3) pre-printed as a completed decorative design in the selected medium so that it is ready for transfer; or (4) blank, and the user draws the desired pattern or decorative design onto the pattern sheet.

Preferably, the initial state of the preparatory composition is a wetted state and the final state is a dried state. Here, the step of curing the preparatory layer is accomplished by allowing it to dry into the stable layer. After drying, the design elements of the pattern will be fully decorated by applying a decorative substance, such as paint, crayon, colored marker or the like to

increase the aesthetic effect of the overall design.

The preparatory composition should be sufficiently viscous so as to resist flowing even when placed in the vertical position such as on the surface of a vertical surface to be decorated. A suitable preparatory composition may be non-toxic substances such as glues (animal and non-animal), stick glues, pastes and egg whites.

IV. STATEMENT OF ISSUES ON APPEAL

The following issues are believed by Appellant to be important for purposes of this Appeal:

- A. Is the recitation of a viscous surface preparatory composition that recites the pattern before cure, as is recited in claim 1, shown in the references?
- B. Is the use of a pattern sheet preprinted in a water soluble medium shown in the art of record?
- C. Is the use of a water-based surface preparatory composition shown in the art of record?
- D. Is the method using both a water as the solvent and the use of a viscous water-based surface preparatory composition, as recited in claim 17, shown in the art of record?
- E. Is there any disclosure in the art of record of the use of stick glues, water-based non-animal glues, water-based animal glues, water-based pastes or egg white for the surface preparatory composition?

V. GROUPING OF THE CLAIMS

Applicant believes that each of claims 1, 4, 13, 15, 17 and 32 contain allowable subject matter. If claim 1 falls, then Applicant agrees that claims 3 and 6-12 should fall. If claim 4 falls, then claim 13 should fall. If claim 17 falls, then Applicant agrees that claims 20 and 21 should fall. Moreover, if both claims 1 and 17 fall, then claims 4 and 13 should fall.

VI. LEGAL ARGUMENT

- A. The process recited in claim 1 of the present invention including the use of a viscous surface preparatory composition is not fully and fairly disclosed in any of the applied references, alone or in combination without resort to hindsight reasoning.

In the Final Office Action, the Examiner withdrew a rejection of claims 1-8, 11-13, 17, 18 and 20 under §102 in light of Applicant's Amendment of September 30, 1994. However, the Examiner still maintains that Applicant's invention is an obviously unpatentable combination of Kitabatake and Takiyama, and Kitabatake, Takiyama and Golchert. Applicant respectively disagrees with these grounds for rejection and asserts that claims of the present application, including claim 1, do indeed recite features not fully and fairly disclosed in any of the Examiner's references, either alone or in combination. A review of these references and claim 1 of the present application will more readily explain Applicant's arguments in this regard.

Kitabatake discloses a transfer process having the following steps: (1) providing a transfer sheet comprising a substrate and a pattern layer of lower alcohol-soluble, water-insoluble dyes on at least one surface of the substrate; (2) wetting the pattern layer of the transfer sheet with a transfer solution containing lower alcohols and bringing the transfer sheet into contact with a receiving surface; (3) maintaining the transfer sheet in close contact with the receiving surface under pressure; and (4) peeling the transfer sheet from the receiving surface to leave the transferred pattern on the receiving surface. The dyes are non-

toxic to the skin, and the transfer pattern contains a solvent which promotes drying at the time of printing by natural drying or forced drying. The solvent may be disbursed in water but is expressly not water-based. When the transfer solution contains a resin, an undercoating film is formed under the transferred pattern. The film undercoating serves a purpose of providing an anchoring effect for the receiving surface and at the same time, protects the dye on the transferred pattern. Kitabatake, however, does not explicitly recite that the transferred solution is curable or that it forms a film on which the pattern is being transferred, as well as the preparatory layer being viscous. (1)

The patent to Takiyama et al discloses a method for coating a stock or shaped body with an active curable resin; placing a pre-printed pattern film to contact the resin with the pattern at a stage where the resin still remains in a liquid or sticky state prior to curing; the pattern being printed with an ink having a greater affinity to the resin than the film; irradiating a beam to cure the resin so that the pattern is transferred to the cured resin surface; and removing the film and then coating the transferred pattern-bearing resin surface with a translucent film.

It is important to recognize that the Takiyama et al reference employs irradiates the materials to cause a physical reaction that sets the pattern. Golchert teaches a method for decorating food items by placing a transparent shield over a selected design to be transferred to the food item. A sheet of thin transfer medium is then placed over the shield and design to be traced. The design is

traced the transfer using edible ink, and the medium is then placed on the food item to be decorated with the colored side down. A damp pad is placed on the exposed back face of the transfer medium, thereby causing the traced design to be transferred to the food item. The design may either be drawn originally or be traced onto a sheet of transfer medium, using various colors of water soluble edible type ink material. The decorator may then use colored frosting or gels to fill in the design on the food item.

As noted, the Examiner attempts to combine the Takiyama et al reference with Kitabatake to yield Applicant's invention. This combination is suspect. Kitabatake is directed to the transfer onto the human skin of a temporary "tattoo" design. Takiyama et al employs a ray-curable resin for its substrate. It is specious to suggest that the ordinarily skilled artisan would think to use an irradiation cure (with ultraviolet light) on the human skin. On the one hand, such resins could be dangerous to the skin. On the other hand, Kitabatake is directed to a user applied skin design which method would not be amenable to the equipment necessary to do a radiation cure. Takiyama et al is directed to an industrial process for decorated surface of a product, such as cement and gypsum products, processed wood products, metals and fabrics. Thus, to combine these references unquestionably resorts to hindsight reasoning.

Claim 1 recites the processing steps of removing the pattern/sheet in contact with the viscous preparatory layer after the transfer of the pattern and before curing of the preparatory

layer, and then curing the preparatory layer into the final state. Claim 1 also clearly recites the spreading of the quantity of a viscous surface preparatory composition onto the area to be covered to form a viscous layer that cures into a stable layer adhered to the surface.

The Examiner admitted in the Final Office Action that Kitabatake does not anticipate the present invention in that the use of a viscous preparatory material is not contemplated by Kitabatake. However, the combination of Kitabatake with either or both of the Takiyama and Golchert references or add nothing to the Kitabatake reference to render an obviousness rejection under §103 appropriate. Golchert is cited by the Examiner merely to show the use of the tracing of the pattern at the time of transfer. With regard to Takiyama, as discussed above, the ordinarily skilled artisan would simply not be led to combine any teaching found in Takiyama et al with Kitabatake. Moreover, Kitabatake specifically wants to avoid any gelatin-like layer.

Therefore, Appellant submits that the inclusion in claim 1 of the recitation of the viscous nature of the preparatory composition, combined with the specific methodology recited therein, cannot not be deemed to be an obvious combination of the references cited by the Examiner, when the Kitabatake reference, the main reference relied on by the Examiner, seems to teach away from the process described in claim 1 of the present application. As such, claim 1 is allowable over the Examiner's §103 rejection and stands in condition for allowance.

B. The use of a pattern sheet preprinted in a water soluble medium is not shown in the art of record.

Claim 17 of the present application, as amended in the response of September 30, 1994, also includes a recitation that the preparatory layer is applied as a viscous preparatory layer. Additionally, however, claim 17 also clearly recites that the pre-printed design is in a water-soluble medium.

Neither Kitabatake nor Takiyama et al disclose the use of a water-soluble ink medium. In fact, Takiyama et al specifically teaches away from the use of such water-soluble materials, noting that water-soluble inks are difficult to create and retain the printed decorative patterns in industrial products. See Column 2, lines 31-35. Kitabatake also avoids any water-soluble transfer solutions or inks which can wash off the surface of the skin. Rather, Kitabatake specifically discloses that the ink solvent is an organic solvent, preferably a monohydric alcohol. See Column 4, lines 37-63. Kitabatake's transfer solution is also a monohydric alcohol, as noted above, which may contain a small amount of resin.

While Appellant agrees that the water-soluble inks are known in the prior art, and are specifically shown in the Golchert reference, a person skilled in the art would not be led to use such water-soluble materials in either the Kitabatake or Takiyama et al processes in view of these patents' specific teachings not to use such soluble mediums or transfer solutions. As such, the Examiner's rejection of claim 17 under §103 is inappropriate, and claim 17 is in condition for allowance.

C. The use of a water-based surface preparatory composition is not shown in the art of record.

Claims 17, 4 and 13 each recited the use of a water-based surface preparatory composition. With respect to claim 17, this is combined with use of the water soluble ink discussed in Section VI.B., above. Neither Kitabatake nor Takiyama disclose a water-based surface preparatory composition. Kitabatake prefers no surface preparatory composition at all, but it does mention that an undercoating of a resin may be used when the transfer solution contains a resin. Column 5, line 67 through Column 6, lines 1-6. Further, where there is a resin in the transfer solution, it is to be soluble in the monohydric alcohols and "insoluble or scarcely soluble in water". Column 6, lines 8-10 (emphasis added). Takiyama et al.

The undercoating resin in Takiyama et al are described to be unsaturated acrylic resins. The solvent carrier for the resins appear to be organic solvents. See, Column 5, lines 8-46.

The processes and chemical systems described in Kitabatake and Takiyama et al references would therefore not be compatible with a water-based system, even if Golchert is read to be a water-based system. Thus, the rejection of these claims on such combined references is not suggested in the applied art and again must be a result to hindsight.

D. The combination of the water-based ink medium and the viscous water-based surface preparatory composition is not disclosed in the art of record.

Claim 17 recites the viscous surface preparatory composition of claim 1 along with the recitation of both the water-based ink

medium and the water-based system of the surface preparatory composition. The arguments for the allowability of these features separately are set forth above in Sections VI, A-C. Therefore, Applicant does not here repeat them but incorporates the same by reference. Applicant suggests, however, that the alleged "obviousness" of combining all three of these features is even more unlikely to ordinarily skilled person without relying on the teachings of the present application.

E. The group of materials from which the preparatory composition is to be selected, specifically, water-based glues, water-based paints and egg whites, as recited in claim 32 of the present application, and the stick glue recited in claim 15 are not fully and fairly disclosed in any of the Examiner's cited references, either alone or in combination.

In Applicant's Amendment of September 30, 1994, claim 32 was added to rewrite former claim 18 in independent form and to recite the group of material from which the preparatory composition is selected. Claim 15 recites the use of stick glue. None of the references cited by the Examiner disclose any of these material being used to produce a surface preparatory layer which has an initial state wherein a pattern is transferred and which cures into the final state.

Rather, Kitabatake teaches the use of a monohydric solution, as noted above, while Takiyama et al teaches use of resin in a liquid or a sticky state as a transfer solution. Golchert shows no equivalent to a surface preparatory composition. Rather, the pattern is transferred by application of a damp cloth or sponge to the back of the pattern.

Accordingly, the Examiner's rejection of claims 15 and 3 under

§103 should not stand.


VII. CONCLUSION

Based on the foregoing, Applicant submits that claims 1, 3, 4, 6-13, 15, 17, 20, 21 and 32 are allowable. Further, Applicant asserts that the Examiner has improperly rejected the appealed claims of this application and has improperly failed to enter an allowance of these claims. As argued above, the appealed claims disclose a number of patentably distinct features not fully and fairly disclosed in the cited references, either alone or in combination.

Therefore, Applicant believes the appealed claims contain allowable subject matter, and respectfully requests that the Board of Appeals reverse the Examiner's decision and grant allowance on these claims.

Respectfully submitted,

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APPENDIX A

I claim:

1. A method of decorating a surface of an item that has an area adapted to display a design, comprising the steps of:

(a) spreading a quantity of a viscous surface preparatory composition onto the area so as to cover the area with a viscous preparatory layer wherein said surface preparatory composition has an initial first state that allows it to be spread onto the surface of the item as the viscous preparatory layer and wherein said surface preparatory composition is curable to a final state that forms a stable layer adhered to the surface;

(b) providing a pattern sheet with the pattern formed thereon in a medium that will transfer onto said surface preparatory composition when in the initial state;

(c) contacting said preparatory layer with said pattern sheet and the pattern thereon for a sufficient time to allow said medium to transfer onto said preparatory layer where a transferred pattern transfers onto said preparatory layer;

(d) removing said pattern sheet from contact with said viscous preparatory layer after the transferred pattern has been transferred thereon yet before said preparatory layer has cured into the final state; and

(e) curing said preparatory layer into the final state thereby fixing the transferred pattern.

2. Claim 2 has been canceled.

3. A method according to claim 1 wherein said surface preparatory composition includes a solvent carrier base material.

4. A method according to claim 3 wherein said solvent carrier is water based.

5. Claim 5 has been canceled.

6. A method according to claim 1 wherein the initial state of said preparatory composition is a wetted state and the final state of said preparatory composition is a dried state, the step of curing said wet layer being accomplished by allowing said preparatory layer to dry into said stable layer.

7. A method according to claim 1 including the step of applying a decorative substance onto said stable layer.

8. A method according to claim 7 wherein the transferred pattern includes a plurality of design elements and wherein said decorative substance is applied in a manner corresponding to the design elements appearing on the transferred pattern.

9. A method according to claim 1 wherein the step of providing the pattern sheet is accomplished by providing a transfer sheet and by drawing the pattern on said transfer sheet in said medium at a time relatively contemporaneously with the step of covering the area with said surface preparatory composition.

10. A method according to claim 9 wherein said transfer sheet is printed with a preprinted pattern, the step of drawing the pattern on said transfer sheet being accomplished by tracing the preprinted pattern with said medium.

11. A method according to claim 1 wherein the step of providing the pattern sheet is accomplished by providing a transfer sheet that is pre-printed with the pattern in said medium.

12. A method according to claim 1 wherein said surface preparatory composition is nontoxic to humans.

13. A method according to claim 1 wherein said surface preparatory composition is water based.

14. Claim 14 has been canceled.

15. A method according to claim 32 wherein said surface preparatory composition is a stick glue.

16. A product formed by a method of claim 1.

17. A method of decorating a surface of an item of produce that has an area of sufficient size to display a design, comprising the steps of:

(a) providing a pattern sheet with the pattern pre-printed thereon in a water soluble medium;

(b) covering the area with a water-based surface preparatory composition that has an initial first state that allows it to be spread onto the surface of the item as a viscous preparatory layer yet which cures into a final state to form a stable layer adhered to the surface, said selected medium being selected as one that will transfer onto said surface preparatory composition when in the initial state;

(c) contacting said preparatory layer with said pattern sheet for a sufficient time to allow said medium to transfer onto said preparatory layer whereby a transferred pattern transfers onto said

preparatory layer and thereafter removing said pattern sheet within a time insufficient to allow said pattern sheet to become affixed to said item of produce; and

(d) allowing said preparatory layer to cure into said final state thereby fixing the transferred pattern on said stable layer.

18. Claim 18 has been canceled.

19. Claim 19 has been canceled.

20. A method according to claim 17 wherein the initial state of said preparatory composition is a wetted state and the final state of said preparatory composition is a dried state, the step of curing said wet layer being accomplished by allowing said preparatory layer to dry into said stable layer.

21. A method according to claim 17 including the step of painting portions of the pattern on said stable layer.

22. A decorated item of produce formed by the method of claim 21.

23. An item of produce formed with a transferred pattern by the method of claim 17.

24. A kit for decorating the surface of an item that has an area adapted to display a design, comprising the steps of:

(a) a surface preparatory composition that has an initial first state that allows it to be spread onto the surface of the item as a preparatory layer yet which cures into a final state to form a stable layer adhered to the surface; and

(b) a pattern sheet having a pattern thereon formed of a medium that will transfer onto said surface preparatory composition

when in the initial state.

25. A kit according to claim 24 wherein said surface preparatory composition includes a solvent carrier base material.

26. A kit according to claim 25 wherein said solvent carrier is water based.

27. A kit according to claim 24 including a plurality of pattern sheets pre-printed with different patterns.

28. A kit according to claim 24 including a plurality of decorative paints, at least some of said decorative paints being of different colors.

29. A kit according to claim 24 wherein said surface preparatory composition is nontoxic to humans.

30. A kit according to claim 24 wherein said surface preparatory composition is selected from a group consisting of: glues, pastes and egg white.

31. A kit for decorating the surface of an item that has an area adapted to display a design, comprising the steps of:

(a) a surface preparatory composition that has an initial first state that allows it to be spread onto the surface of the item as a preparatory layer yet which cures into a final state to form a stable layer adhered to the surface;

(b) a pattern sheet; and

(c) a pattern forming medium that is adapted to be placed on said pattern sheet in a selected pattern, said medium being of a type that will transfer onto said surface preparatory composition when in the initial state.

32. A method of decorating a surface of an item that has an area adapted to display a design, comprising the steps of:

(a) covering the area with a surface preparatory composition that has an initial first state that is sufficiently viscous to allow it to be spread onto the surface of the item as a preparatory layer, said surface preparatory composition being selected from a group consisting of: water-based non-animal glues, water-based animal glues, water-based pastes and egg white;

(b) providing a pattern sheet with the pattern formed thereon in a medium that will transfer onto said surface preparatory composition when in the initial state; and

(c) contacting said preparatory layer with said pattern sheet and the pattern thereon for a sufficient time to allow said medium to transfer onto said preparatory layer where a transferred pattern transfers onto said preparatory layer.